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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/777,347
Filing Date: February 12, 2004
Appellant(s): SOJIAN ET AL.

Gerald Maliszewski
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/15/09 appealing from the Office action mailed 12/15/08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,919,967	Pentecost et al.	7-2005
5,959,743	Tanaka	9-1999
6,538,623	Parnian et al.	3-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1) Claims 1-5, 7-11, 17-21 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,919,967 by Pentecost et al., and further in view of U.S. patent 5,959,743 by Tanaka.
- 2) Regarding claims 1 and 17, Pentecost teaches in a multifunctional peripheral (MFP) (column 6, line 5; figure 1, item 18), a text overlaying method comprising: accepting a document; converting the document to rasterized data (Pentecost teaches various techniques to rasterize data, one example is the rasterizing of static data in column 8, lines 41-42); generating a first image (column 8, lines 42-43; rasterizing the data creates a raster image file such as the static page layout object transmitted to DMU 50); in a print pipeline, accepting an electronically formatted text overlay message (column 8, lines 53-54; static data [first image data] and variable data [second image data, overlay message] are both submitted from a host PC into a print pipeline);

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converting the overlay message to a page description language (PDL) file (MDPP 48 as taught in column 6, lines 65-67 turns variable data into an “optimized form”, a “form” being PDL data as taught in column 5, lines 17-19); processing the PDL file as a print job; and generating a second image as rasterized data (column 8, lines 53-54; variable PDL data is rasterized); merging the first image with the second image; and, creating a merged document (column 8, lines 55-64).

Pentecost does not specifically teach in a copier pipeline, accepting a document.

Tanaka teaches in a copier pipeline, accepting a document (figure 8; column 6, lines 15-20; copier pipeline is defined in applicant's specification as data gained from a scanner, data such as image data gained from scanner unit 100).

Pentecost and Tanaka are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Tanaka to add a second pipeline of data from a scanner. The motivation for doing so would have been to have “an image processing apparatus with an image overlaying mechanism by which image data from an inputting means source are overlaid with image data stored in memory” (Tanaka abstract). Therefore it would have been obvious to combine Pentecost with Tanaka to obtain the invention as specified by claims 1 and 17.

NOTE: The merge unit of Pentecost (DMU 50) would not function differently because of the combination above, it takes two inputs and merges them together, it

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would not matter that the inputs are no longer from the same original file as taught by Pentecost, they could still be merged pixel by pixel.

- 3) Regarding claims 2 and 18, Pentecost teaches the method of claim 1 further comprising: creating a paper media merged document (column 8, line 62).
- 4) Regarding claims 3 and 19, Pentecost teaches the method of claim 1 wherein accepting a document includes accepting a document selected from the group including paper media and electronically formatted documents (column 7, lines 40-42; pages from an application are electronic).
- 5) Regarding claims 4 and 20, Pentecost teaches the method of claim 3 wherein accepting an electronically formatted document includes accepting a document selected from the group including text and image documents (column 5, lines 9-16).
- 6) Regarding claims 5 and 21, Pentecost teaches the method of claim 1 further comprising: electronically transmitting the merged document (column 8, lines 59-62; transmitted from DMU to print engine).
- 7) Regarding claims 7 and 23, Pentecost teaches the method of claim 1 wherein creating the merged document includes generating a third image (column 8, lines 54-60).
- 8) Regarding claim 8, Pentecost teaches the method of claim 7 wherein printing the merged document includes sending the third image to an MFP print engine (column 8, line 61).
- 9) Regarding claims 9 and 24, Pentecost teaches the method of claim 1 wherein converting the overlay message to a PDL file includes converting the overlay message

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to a PDL file selected from the group including Printer Control Language (PCL) and PostScript (PS) (column 6, lines 8 and 9).

10) Regarding claims 10 and 25, Pentecost teaches the method of claim 1 wherein merging the second image with the first image includes accepting position commands for positioning the second image with respect to the first image (column 11, lines 18-25).

11) Regarding claims 11 and 26, Pentecost teaches the method of claim 10 wherein merging the second image with the first image includes accepting message characteristics selection commands chosen from the group including message size, message shape, font, color, and print options (column 9, lines 18-30).

12) Regarding claims 12 and 27, Pentecost does not specifically teach the method of claim 11 wherein accepting message characteristics selection commands includes: supplying user interface (UI) message characterization prompts at an MFP front panel; and, accepting user commands from the UI.

Tanaka teaches the method of claim 11 wherein accepting message characteristics selection commands includes: supplying user interface (UI) message characterization prompts at an MFP front panel; and, accepting user commands from the UI (figure 1, item 302; column 4, lines 15-19).

Pentecost and Tanaka are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Tanaka to add a UI to an MFP. The motivation for doing so would have been for an "operator" to "set parameters" (Column

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4, lines 16-17). Therefore it would have been obvious to combine Pentecost with Tanaka to obtain the invention as specified by claims 12 and 27.

13) Regarding claims 15 and 30, Pentecost teaches the method of claim 1 wherein accepting an overlay message includes accepting an overlay message from an interface.

Pentecost does not specifically teach an interface selected from the group including a scanner, stylus, smart card, virtual keyboard, and wireless personal digital assistant (PDA) interface.

Tanaka teaches an interface selected from the group including a scanner, stylus, smart card, virtual keyboard, and wireless personal digital assistant (PDA) interface (column 3, lines 20-27; figure 1).

Pentecost and Tanaka are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Tanaka to add a scanner to an MFP. The motivation for doing so would have been to input data. Therefore it would have been obvious to combine Pentecost with Tanaka to obtain the invention as specified by claims 15 and 30.

14) Claims 13 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,919,967 by Pentecost et al., and further in view of U.S. patent 5,959,743 by Tanaka, and further in view of U.S. patent 7,126,704 by Miura et al.

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15) Regarding claims 13 and 28, Pentecost does not specifically teach the method of claim 10 wherein accepting position commands for positioning the overlay message with respect to the document includes: on an MFP display, presenting an image of the document; using a UI associated with the display, supplying prompts for superimposing the overlay message on the document; receiving user commands on the UI; positioning the overlay message in response to the commands.

Miura teaches the method of claim 10 wherein accepting position commands for positioning the overlay message with respect to the document includes: on a display, presenting an image of the document (column 11, lines 52-60); using a UI associated with the display, supplying prompts for superimposing the overlay message on the document; receiving user commands on the UI; positioning the overlay message in response to the commands (column 12, lines 11-45).

Pentecost and Miura are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Miura to add altering merge data on a display. The motivation for doing so would have been to be able to preview user actions.

Tanaka teaches an MFP display (figure 1, item 302).

Pentecost and Tanaka are combinable because they are both from the printing field of endeavor.

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Tanaka to add an MFP display device. The motivation for doing so would have been to allow an operator to “set parameters .. and provide commands” (column 4, lines 16-19).

Therefore it would have been obvious to combine Pentecost with Miura and Tanaka to obtain the invention as specified by claims 13 and 28.

16) Claims 14, 16, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,919,967 by Pentecost et al., and further in view of U.S. patent 5,959,743 by Tanaka, and further in view of U.S. patent 6,538,623 by Parnian et al.

17) Regarding claims 14 and 29, Pentecost teaches the method of claim 1 wherein accepting an overlay message includes: from an MFP controller; converting the ASCII code to a PDL file; and, generating a rasterized overlay message (column 8, lines 53-54).

Pentecost does not specifically teach receiving an ASCII code timestamp, including a date and time.

Parnian teaches receiving an ASCII code timestamp, including a date and time (column 36, lines 15-62).

Pentecost and Parnian are combinable because they are both from the printing field of endeavor.

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Parnian to add timestamps. The motivation for doing so would have been to know when a modification is made (column 8, line 62). Therefore it would have been obvious to combine Pentecost with Parnian to obtain the invention as specified by claims 14 and 29.

18) Regarding claims 16 and 31, Pentecost does not specifically teach the method of claim 1 further comprising: generating dynamic data selected from the group including document page count, timestamp, MFP name, and MFP identification (ID); and, wherein merging the overlay message with the document includes additionally merging the dynamic data with the document.

Parnian teaches the method of claim 1 further comprising: generating dynamic data selected from the group including document page count, timestamp, MFP name, and MFP identification (ID); and, wherein merging the overlay message with the document includes additionally merging the dynamic data with the document (column 36, lines 15-62).

Pentecost and Parnian are combinable because they are both from the printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pentecost with Parnian to add timestamps. The motivation for doing so would have been to know when a modification is made (column 8, line 62). Therefore it would have been obvious to combine Pentecost with Parnian to obtain the invention as specified by claims 16 and 31.

(10) Response to Argument

1) Regarding applicant's argument for claims 1-5, 7-11, 17-21 and 24-26 that the combination of Pentecost and Tanaka does not teach the document merger as described in the claims, examiner disagrees and will first clarify how the combination of the two references would work. The apparatus of Pentecost, as seen in figure 1, teaches a memory 44 with a static page buffer (i.e. the first pipeline [pipeline being interpreted as any individual stream of data]) and a variable page buffer (i.e. a second pipeline of data). Since the teachings of Pentecost could be applied to a fax machine, a copier, an MFP, network printers, etc. (as stated in column 6, lines 4-6) the two pipelines described above would either be both "print pipelines" or they would both be "copier pipelines" depending upon the system the method of Pentecost was used in. Since Pentecost does not teach the mix of one copier/scanner pipeline and one print pipeline, Tanaka is used to remedy the deficiency. In the case that both pipelines of Pentecost were print pipelines, one buffer (and therefore one pipeline) could be replaced by a buffer of Tanaka (such as figure 9, item 95; column 7, lines 7-13) which contains data originating from a scanner and would thus be a "copier pipeline". This combination would produce a printer/MFP/etc. with an attached scanner (which would not change the principle operation of Pentecost as MFP's are very well known to include scanners) and accompanying buffer within the memory 44 of Pentecost that would be considered a copier pipeline. While Pentecost teaches that the data in the two pipelines

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originate from the same image, by the time the image data is separated and into the two pipelines, the DMU 50 of Pentecost would not function any differently as it simply combines, pixel by pixel, two rasterized images.

Regarding applicant's arguments on pages 7-9, for claim 1 that generally state that Pentecost's two streams (i.e. pipelines) come from a single document and therefore do not teach the claim limitations, examiner disagrees. As explained above the single origin of the two pipelines is immaterial to the operation of the pipelines and the merger unit of Pentecost.

In response to applicant's argument on page 9, paragraph 2, for claim 1 that Pentecost does not teach that the original document has been merged with another document, examiner submits that two different documents are not claimed, only one document and an overlay message is claimed, which is consistent with the invention of Pentecost, as the static data could be the document and the variable data the overlay message.

Regarding applicant's argument on page 10, paragraph 2, that Tanaka does not teach a print pipeline, only a memory pipeline, examiner disagrees. As discussed above, the memory unit (as stated in column 4, lines 49-53) can simply print when no overlay occurs making the image memory a "printer pipeline".

Regarding applicant's argument on page 10, paragraph 3, that Tanaka does not teach processing PDL data that is rasterized, examiner agrees, however Tanaka is not cited as teaching this feature, Pentecost is, therefore the argument is moot.

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All other arguments regarding applicant's statement for claim 1, that the combination of Pentecost and Tanaka does not teach two separate pipelines (one a printer pipeline, the other a scanner/copier pipeline), are believed to have been addressed in the responses above

2) Applicant's arguments for claims 13 and 28 are rebutted in the same manner as above.

3) Applicant's arguments for claims 14, 16, 29 and 31 are rebutted in the same manner as above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Benjamin O Dulaney/

Examiner, Art Unit 2625

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Art Unit: 2625

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